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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,824

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Hans-Peter Mettler

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FISHER, CHRISTEN & SABOL

1120 20TH STREET, NW, SOUTH TOWER, SUITE 750

WASHINGTON, DC 20036

EXAMINER

YOUNG, SHAWQUA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

11/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,824	<b>Applicant(s)</b> METTLER, HANS-PETER	
	<b>Examiner</b> SHAWQUIA YOUNG	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-11 and 13-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-11 and 13-23 are currently pending in the instant application.

Applicants have amended claims 1, 4, 6, 12, 14, 16 and 17 in an amendment filed on August 19, 2008.

#### **I. *Response to Arguments/Remarks***

Applicant's amendment, filed on July 9, 2008, has overcome the rejection of claims 4-11 and 17 under 35 USC 112, 2nd paragraph as being indefinite; the rejection of claims 6-11, 14 and 15; the rejection of claim 22 for lacking antecedent basis and the objection of claim 1 for informalities. The above rejections and objection have been withdrawn.

#### **II. *Rejection(s)***

#### **35 USC § 103 - OBVIOUSNESS REJECTION**

The following is a quotation of 35 U.S.C. § 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Graham v. John Deere Co.* set forth the factual inquiries necessary to determine

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obviousness under 35 U.S.C. §103(a). See *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966). Specifically, the analysis must employ the following factual inquiries:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ding, et al.* (See CAPLUS). Applicants claim a process for the preparation of a chiral compound



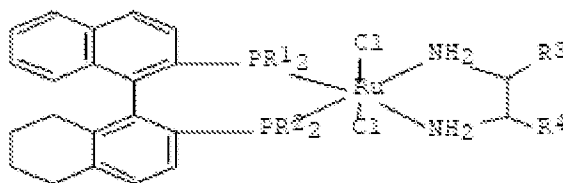
of formula

wherein X represents S or O and R represents

hydrogen, C1-6 alkyl, C3-5 cycloalkyl, aryl or aralkyl, each aryl or aralkyl being optionally further substituted as defined in claim 1 which process comprises the asymmetric hydrogenation of a compound of formula II wherein X and R are as defined above in the presence of a transition metal complex of a chiral bidentate phosphine ligand, that is a stabilizing and optionally a base.

**The Scope and Content of the Prior Art (MPEP §2141.01)**

*Ding, et al.* teaches an asymmetric catalytic hydrogenation of ketones by using a



Ru complex of formula

as a catalyst. The

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various reactions disclosed in the reference include

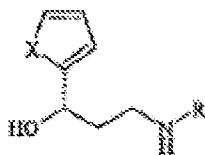


**The Difference Between the Prior Art and the Claims (MPEP §2141.02)**

The difference between the prior art of *Ding, et al.* and the instant invention is that the amine in the structure in the instant compounds is a methyl amine (secondary) whereas the amine in the prior art is a dimethyl amine (tertiary).

**Prima Facie Obviousness-The Rational and Motivation (MPEP §2142-2413)**

Applicants are claiming a process for preparing a compound of



formula

wherein the variables are as defined in claim 1 which the

process comprises the asymmetric hydrogenation of a compound of formula II in the presence of a transition metal complex of a chiral bidentate phosphine ligand. The prior art reference of *Ding, et al.* teaches a similar process wherein the amine group in the compound is a dimethyl amine(tertiary) versus a methyl amine (secondary) in the instant compound.

In Ex parte Bluestone, 135 USPQ 199, it was well established that the interchange of alkyl and hydrogen is obvious in and of itself and in addition secondary and tertiary amines are interchangeable. For example, it is obvious to prepare a beta amino ketone wherein the amine group is substituted with an alkyl group (i.e. methyl) using asymmetric hydrogenation in the presence of a transition metal complex of a chiral bidentate phosphine ligand when the art teaches a similar process wherein the amine group in the ketone is disubstituted with dimethyl with a reasonable expectation of success. Specifically, a monomethyl substituted beta-amino ketone and a dimethyl substituted beta-amino ketone are considered homologues and are obvious absent unexpected results. Therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to prepare adjacent homologs by using asymmetric hydrogenation based on the teachings of the prior art. A strong prima facie obviousness has been established.

### **III. *Objections***

#### *Dependent Claim Objections*

Dependent Claims 2-11 and 13-23 are also objected to as being dependent upon a rejected based claim. To overcome this objection, Applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim.

#### **IV. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed/

Primary Examiner, Art Unit 1626

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